

REMARKS

The Office Action dated August 24, 2005 (hereinafter "Office Action") has been carefully reviewed. Claims 1 and 4-20 are pending in this patent application. By this amendment, claims 1, 13, and 14 have been amended, claims 4-5 have been canceled. Reconsideration of this application, as amended, is respectfully requested.

First 35 U.S.C. § 102 Rejection

Claims 1 and 4-20 were rejected under 35 U.S.C. § 102 as being anticipated by Fallin (U.S. Patent No. 5,108,452). Claims 1, 13, and 14 have been amended to more clearly define the invention, while claims 4-5 have been canceled. Reconsideration of claims 1 and 6-20, as amended, is respectfully requested.

Discussion Regarding Patentability of Amended Claim 1

Amended Claim 1

Claim 1, as amended, recites the following limitations:

a head member defining a coupler bore, said head-receiving support member of said neck member being received within said coupler bore,

wherein said sleeve component is located completely outside of said coupler bore of said head member,

Fallin does not disclose these limitations. Significantly, item 46 which was identified in the Office Action as the "sleeve" is located within the coupler bore of Fallin's head member 27. Thus, Fallin's sleeve is not "located completely outside

of said coupler bore of said head member" as required by Applicants' amended claim 1.

It is axiomatic that anticipation of a claim under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Since Fallin does not disclose each and every element of Applicants' amended claim 1, Fallin does not anticipate Applicants' amended claim 1.

Discussion Regarding Patentability of Claims 6-13

Each of claims 6-13 depends directly or indirectly from amended claim 1. As a result, each of claims 6-13 is allowable for, at least, the reasons hereinbefore discussed with regard to amended claim 1.

Second 35 U.S.C. § 102 Rejection

Claims 1, 4, and 6-11 were rejected under 35 U.S.C. § 102 as being anticipated by Brooks et al. (U.S. Patent No. 5,658,349). Claim 1 has been amended to more clearly define the invention, while claim 4 has been canceled. Reconsideration of claims 1 and 6-11 is respectfully requested.

Discussion Regarding Patentability of Amended Claim 1

Amended Claim 1

As stated above, amended claim 1 recites the following limitations:

wherein said terminal distal end of said neck member is located within an interior space of said stem member.

Brooks does not disclose this limitation. In particular, as clearly can be seen in its FIG. 4, the terminal distal end of Brooks' item 28 (presumably identified in the Office Action at the neck member) is not located within an interior space of its item 32 (presumably identified in the Office Action as the stem member). Since Brooks does not disclose each and every element of Applicants' amended claim 1, Brooks does not anticipate Applicants' amended claim 1.

Discussion Regarding Patentability of Claims 6-11

Each of claims 6-11 depends directly or indirectly from amended claim 1. As a result, each of claims 6-11 is allowable for, at least, the reasons hereinbefore discussed with regard to amended claim 1.

35 U.S.C. § 103 Rejection

Claims 5 and 13-19 were rejected under 35 U.S.C. § 103 as being unpatentable over Brooks et al. in view of Fallin. Claims 13 and 14 have been amended to more clearly define the invention, while claim 5 has been canceled. Reconsideration of claims 13-19, as amended, is respectfully requested.

Discussion Regarding Patentability of Amended Claim 14

Amended claim 14 recites the following limitations:

14. A modular prosthesis, comprising:
 - a neck member having (i) a head-receiving portion, (ii) a tapered neck body connected to said head-receiving portion, (iii) a transition portion having a first end connected to said tapered neck body and a second end, and (iv) a tapered post connected to said second end of said transition portion;
 - a head defining a coupler bore, said head-receiving portion of said neck member being positioned within said coupler bore;

a sleeve component having a first elongated tapered bore, said tapered neck body being received within said first elongated tapered bore so as to taper lock said sleeve component to said neck member; and
 a stem member having a second elongated tapered bore, said stem member configured to be implanted into a medullary canal of a bone,
 wherein said tapered post of said neck member is received within said second elongated tapered bore of said stem member so as to taper lock said neck member to said stem member,
 wherein no portion of said stem member is located within said first elongated tapered bore,
 wherein said sleeve component is located completely outside of said coupler bore of said head member, and
 wherein a terminal distal end of said neck member is located within an interior space of said stem member.

The combination of Brooks and Fallin proposed in the Office Action (at page 5, lines 15-17) is as follows:

 It would have been obvious ... to have provided a separate head member received on a head receiving portion of a neck member of Brooks et al. prosthesis, as taught by Fallin.

However, even if it would have been obvious to modify Brooks as described above, the resulting modification/combination does not arrive at the invention of amended claim 14. Significantly, the terminal distal end of Brooks' item 28 (presumably identified in the Office Action at the neck member) is not located within an interior space of its item 32 (presumably identified in the Office Action as the stem member). Thus, the proposed modification/combination of Brooks and Fallin does not arrive at the invention of amended claim 14. Accordingly, the proposed modification/combination of Brooks and Fallin does not establish a *prima facie* case of obviousness under 35 U.S.C. § 103 with regard to the invention of amended claim 14.

Discussion Regarding Patentability of Claims 15-19

Each of claims 15-19 depends directly or indirectly from amended claim 14. As a result, each of claims 15-19 is allowable for, at least, the reasons hereinbefore discussed with regard to amended claim 14.

Discussion Regarding Patentability of Claim 13

Claim 13 has been amended to depend directly from amended claim 1. As a result, amended claim 13 is allowable for, at least, the reasons hereinbefore discussed with regard to amended claim 1.

Conclusion

In view of the foregoing amendments and remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

Respectfully submitted,
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